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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

SEMICAPS PTE LTD.

Plaintiff,

v.

HAMAMATSU CORPORATION, *et al.*

Defendants.

Case No: 17-cv-03440-DMR

**JOINT CLAIM CONSTRUCTION AND
PRE-HEARING STATEMENT**

[PATENT L.R. 4-3]

Judge: Magistrate Judge Donna M. Ryu

Hearing Date: January 9, 2020
Time: 1:00 PM
Courtroom 4 – 3rd Floor

Pursuant to Patent L. R. 4-3 (“Pat. L.R.”), and the Court’s Case Management Order, dated May 2, 2019 (Dkt. No. 48), Plaintiff SEMICAPS Pte Ltd. (“Plaintiff” or “SEMICAPS”) and Defendants Hamamatsu Photonics K.K., Hamamatsu Corporation, and Photonics Management System (collectively, “Defendants” or “Hamamatsu”) jointly submit this Claim Construction and Prehearing Statement in connection with U.S. Patent No. 7,623,982 (“the ’982 patent”):

1. Construction Of Claim Terms On Which The Parties Agree (Pat. L.R. 4-3(a))

The parties have agreed to the following claim constructions:

Claim Term/Phrase	Claim(s)	Agreed Claim Construction
“accumulating”	1, 17, 21	“gathering together, increasing, or adding”
“accumulated”		“gathered together, increased, or added”
“accumulates”		“gathers together, increases, or adds”

2. Proposed Construction of Disputed Terms (Pat. L. R. 4-3(b))

The parties met and conferred pursuant to Pat. L.R. 4-1(b) and Pat. L.R. 4-2(c) on August 27, 2019 but were unable to reach agreement on the terms identified in the following table. The parties proposed constructions and intrinsic and extrinsic evidence are reflected in the following table:

Claim Element	Hamamatsu’s Proposed Construction	Hamamatsu’s Evidence	SEMICAPS’ Proposed Construction	SEMICAPS’ Evidence
“control system”	Governed by 35 U.S.C. § 112(6) Structure(s), act(s), or material(s) corresponding to the term’s function: Indefinite	<u>Intrinsic Evidence</u> Fig. 1; Fig. 2; 2:12-19; 2:29-33; 2:67-3:2; 3:20-24; 3:30-35; 3:36-48; 4:30-33 February 19, 2009 Non-Final	Not governed by 35 U.S.C. § 112(6) and no construction needed. If it is deemed to be governed by 35 U.S.C. § 112(6), then SEMICAPS identifies the following structure: any	<u>Intrinsic Evidence</u> Fig. 1 (and related descriptions); Fig. 2 (and related descriptions); 2:12-33; 2:67; 3:2; 3:20-4:30 February 19, 2009 Non-Final

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
		<p>Rejection; May 19, 2009 Response to February 19, 2009 Office Action</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration(s), including from Dr. Hobbs, testifying that a person of ordinary skill in the art would not understand the specification of the '982 patent as describing any structure(s), act(s), or material(s) corresponding to the function of this claim term</p>	<p>controller or control structure capable of performing the recited function of directing a laser beam source to dwell on a location of the electronic circuit.</p>	<p>Rejection; May 19, 2009 Response to February 19, 2009 Office Action</p> <p>The Petitions (and supporting documents), Institution Decisions, Replies to Patent Owner Responses (and supporting documents), Opposition to Motion to Amend (and supporting documents), Deposition Transcripts, Expert Declarations and Final Written Decisions from IPR2017-02110 and IPR2017-02112.</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration of Dr. Woods, testifying that a person of ordinary skill in the art would understand this claim term to have a sufficiently definite meaning as the name for structure. To the extent this element is deemed to be a means plus function term, Dr.</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
				Woods will identify structure as it would be understood by one skilled in the art.
"measuring circuit"	<p>Governed by 35 U.S.C. § 112(6)</p> <p>Structure(s), act(s), or material(s) corresponding to the term's function:</p> <p>Indefinite</p>	<p><u>Intrinsic Evidence</u></p> <p>Fig. 1; Fig. 2; Fig. 3; 2:12-19; 2:29-33; 2:34-36; 2:67-3:2; 3:49-54; 3:55-59; 3:60-64; 4:11-15; 4:52-57; 5:25-6:2; 6:14-19; 6:20-24</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration(s), including from Dr. Hobbs, testifying that a person of ordinary skill in the art would not understand the specification of the '982 patent as</p>	<p>Not governed by 35 U.S.C. § 112(6) and no construction needed.</p> <p>If it is deemed to be governed by 35 U.S.C. § 112(6), then SEMICAPS identifies the following structure: a measuring circuit capable of performing the recited function of determining a plurality of samples of a response signal output by the electronic circuit during the period when the laser beam is radiated</p>	<p><u>Intrinsic Evidence</u></p> <p>Fig. 1 (and related descriptions); Fig. 2 (and related descriptions); Fig. 3 (and related descriptions); 2:12-36; 2:67-3:2; 3:20-47; 3:49-64; 4:11-15; 4:52-57; 5:25-6:2; 6:14-19; 6:20-24</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action</p> <p>The Petitions (and supporting documents), Institution Decisions, Replies to Patent Owner Responses (and supporting documents), Opposition to Motion to Amend (and supporting documents), Deposition Transcripts, Expert</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
		describing any structure(s), act(s), or material(s) corresponding to the function of this claim term		<p>Declarations and Final Written Decisions from IPR2017-02110 and IPR2017-02112.</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration of Dr. Woods, testifying that a person of ordinary skill in the art would understand this claim term to have a sufficiently definite meaning as the name for structure. To the extent this element is deemed to be a means plus function term, Dr. Woods will identify structure as it would be understood by one skilled in the art.</p>
"signal processor"	<p>Governed by 35 U.S.C. § 112(6)</p> <p>Two corresponding functions:</p> <p>(1) "accumulates the plurality of samples to generate a value"</p>	<p><u>Intrinsic Evidence</u></p> <p>Fig. 1; Fig. 2; 2:19-22; 2:29-33; 2:67-3:2; 3:65-4:7; 4:52-57</p> <p>February 19, 2009 Non-Final Rejection; May</p>	<p>Not governed by 35 U.S.C. § 112(6) and no construction needed.</p> <p>If it is deemed to be governed by 35 U.S.C. § 112(6), then SEMICAPS identifies the</p>	<p><u>Intrinsic Evidence</u></p> <p>Fig. 1 (and related descriptions); Fig. 2 (and related descriptions); 2:19-33; 2:67-3:2; 3:35-47; 3:65-4:7; 4:52-57</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
	<p>(2) “generates a test result based on the value”</p> <p>Structure(s), act(s), or material(s) corresponding to the term's function (1):</p> <p>“a microprocessor including complex instruction set computer (CISC) processor or reduced instruction set computer (RISC) processor” (4:2-7) programmed with the algorithm described in column 9, lines 13-19</p> <p>Structure(s), act(s), or material(s) corresponding to the term's function (2):</p> <p>Indefinite</p>	<p>19, 2009 Response to February 19, 2009 Office Action</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration(s), including from Dr. Hobbs, testifying that a person of ordinary skill in the art would (a) understand the specification of the '982 patent as describing the structure of “signal processor” for the “accumulates the plurality of samples to generate a value” function as “a microprocessor including complex instruction set computer (CISC) processor or reduced instruction set computer (RISC) processor” programmed with the algorithm described in column 9, lines 13-19, and (b) not understand the</p>	<p>following structure: a digital signal processor or a programmable processor, e.g., a microprocessor capable of performing the recited functions of accumulating the plurality of samples to generate a value, and generating a test result based on the value.</p>	<p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action</p> <p>The Petitions (and supporting documents), Institution Decisions, Replies to Patent Owner Responses (and supporting documents), Opposition to Motion to Amend (and supporting documents), Deposition Transcripts, Expert Declarations and Final Written Decisions from IPR2017-02110 and IPR2017-02112.</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration of Dr. Woods, testifying that a person of ordinary skill in the art would understand this claim term to have a sufficiently definite meaning as the name for structure. To the</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
		specification of the '982 patent as describing any structure(s), act(s), or material(s) corresponding to the "generates a test result based on the value" function of "signal processor"		extent this element is deemed to be a means plus function term, Dr. Woods will identify structure as it would be understood by one skilled in the art.
"value"	"a representation of the response signal output by the electronic circuit during the period when the laser beam is radiated"	<p><u>Intrinsic Evidence</u></p> <p>Abstract; Fig. 2; Fig. 5(a)-(f); Fig. 6; 2:8-10; 2:19-22; 2:31-33; 2:39-45; 3:65-4:7; 4:63-65; 4:66-5:4; 5:5-16; 6:43-53; 6:59-67; 7:1-22; 7:23-30; 7:31-37; 8:15-19; 8:20-23; 8:24-29; 8:30-33; 8:34-37; 8:38-50; 8:51-9:12; 9:13-20</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action; August 21, 2009 Notice of Allowance</p> <p><u>Extrinsic Evidence</u></p>	<p>This term needs no construction and can be understood by its plain and ordinary meaning.</p> <p>If it is determined that a construction for "value" is needed SEMICAPS proposes the following construction: "a magnitude, quantity or number"</p>	<p><u>Intrinsic Evidence</u></p> <p>Abstract; Fig. 1 (and related descriptions); Fig. 2 (and related descriptions); Fig. 5(a)-(f) (and related descriptions); Fig. 6 (and related descriptions); 2:2-23; 3:65-4:7; 4:63-65; 4:66-5:4; 5:5-16; 6:35-53; 6:59-67; 7:1-22; 7:23-30; 7:31-37; 8:8-9:20</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action; August 21, 2009 Notice of Allowance</p> <p>The Petitions (and supporting documents), Institution</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
		Expert declaration(s), including from Dr. Hobbs, testifying that a person of ordinary skill in the art would understand this claim term to mean the construction proposed by Hamamatsu		<p>Decisions, Replies to Patent Owner Responses (and supporting documents); Opposition to Motion to Amend (and supporting documents); Deposition Transcripts, Expert Declarations and Final Written Decisions from IPR2017-02110 and IPR2017-02112.</p> <p><u>Extrinsic evidence</u></p> <p>Expert declaration of Dr. Woods, testifying that a person of ordinary skill in the art would understand this claim term to mean the construction proposed by Semicaps.</p> <p>The New IEEE Standard Dictionary of Electrical and Electronics Terms, IEEE Std. 100-1992</p> <p>Webster's New World College Dictionary, Fourth Edition</p> <p>Merriam-Webster online dictionary</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
				Oxford online dictionary
"another value"	"a representation of the response signal output by the electronic circuit during the period when the laser beam is not radiated"	<p><u>Intrinsic Evidence</u></p> <p>Abstract; Fig. 2; Fig. 5(a)-(f); Fig. 6; 2:8-10; 2:19-22; 2:31-33; 2:39:45; 3:65-4:7; 4:63-65; 4:66-5:4; 5:5-16; 6:43-53; 6:59-67; 7:1-22; 7:23-30; 7:31-37; 8:15-19; 8:20-23; 8:24-29; 8:30-33; 8:34-37; 8:38-50; 8:51 9:12; 9:13-20</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action; August 21, 2009 Notice of Allowance</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration(s), including from Dr. Hobbs, testifying that a person of ordinary skill in the art would</p>	<p>This term needs no construction and can be understood by its plain and ordinary meaning.</p> <p>If it is determined that a construction for "another value" is needed SEMICAPS proposes the following construction: "another magnitude, quantity or number"</p>	<p><u>Intrinsic Evidence</u></p> <p>Abstract; Fig. 1 (and related descriptions); Fig. 2 (and related descriptions); Fig. 5(a)-(f) (and related descriptions); Fig. 6 (and related descriptions); 2:2-23; 3:65-4:7; 4:63-65; 4:66-5:4; 5:5-16; 6:35-53; 6:59-67; 7:1-22; 7:23-30; 7:31-37; 8:8-9:20</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action; August 21, 2009 Notice of Allowance</p> <p>The Petitions (and supporting documents), Institution Decisions, Replies to Patent Owner Responses (and supporting documents); Opposition to Motion to Amend (and supporting</p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
		understand this claim term to mean the construction proposed by Hamamatsu		documents); Deposition Transcripts, Expert Declarations and Final Written Decisions from IPR2017-02110 and IPR2017-02112. <u>Extrinsic Evidence</u> Expert declaration of Dr. Woods, testifying that a person of ordinary skill in the art would understand this claim term to mean the construction proposed by SEMICAPS. The New IEEE Standard Dictionary of Electrical and Electronics Terms, IEEE Std. 100-1992 Webster's New World College Dictionary, Fourth Edition Merriam-Webster online dictionary Oxford online dictionary
"test result"	"determination of whether the circuit is faulty"	<u>Intrinsic Evidence</u>	This term needs no construction and can be understood by its	<u>Intrinsic evidence</u>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
		<p>Abstract; Fig. 2; Fig. 4; Fig. 9(a)-(d); 2:8-10; 2:19-22; 2:31-33; 2:37-38; 2:55-57; 3:67-4:2; 4:16-24; 4:66-5:4; 5:5-16; 5:17-24; 8:15-19; 8:20-23; 8:24-29; 8:30-33; 8:34-37; 8:38-50; 8:51-9:12; 9:13-20; 9:58-10:22</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action; August 21, 2009 Notice of Allowance</p> <p><u>Extrinsic Evidence</u></p> <p>Expert declaration(s), including from Dr. Hobbs, testifying that a person of ordinary skill in the art would understand this claim term to mean the construction proposed by Hamamatsu</p>	<p>plain and ordinary meaning.</p> <p>If it is determined that a construction for “test result” is needed SEMICAPS proposes the following construction:</p> <p>“determination from the testing of an electronic circuit”</p>	<p>Abstract; Fig. 2 (and related descriptions); Fig. 4 (and related descriptions); Fig. 9(a)-(d) (and related descriptions); 1:10-67; 2:8-22; 2:31-57; 3:67-4:2; 4:16-24; 4:66-5:24; 8:15-9:20; 9:58-10:22</p> <p>February 19, 2009 Non-Final Rejection; May 19, 2009 Response to February 19, 2009 Office Action; August 21, 2009 Notice of Allowance</p> <p>The Petitions (and supporting documents), Institution Decisions, Replies to Patent Owner Responses (and supporting documents); Opposition to Motion to Amend (and supporting documents); Deposition Transcripts, Expert Declarations and Final Written Decisions from IPR2017-02110 and IPR2017-02112.</p> <p><u>Extrinsic Evidence</u></p>

Claim Element	Hamamatsu's Proposed Construction	Hamamatsu's Evidence	SEMICAPS' Proposed Construction	SEMICAPS' Evidence
				Expert declaration of Dr. Woods, testifying that a person of ordinary skill in the art would understand this claim term to mean the construction proposed by SEMICAPS.

3. Most Significant and Dispositive Terms (Pat. L.R. 4-3(c))

Patent Local Rule 4-3(c) requires the parties to identify the ten most significant disputed terms for construction. The parties have identified only six terms for construction and therefore agree this requirement is satisfied. Patent Local Rule 4-3(c) further requires the parties to identify any disputed terms whose construction will be case or claim dispositive.

Hamamatsu's Position. Hamamatsu's position is that each term is case or claim dispositive. If the Court adopts Hamamatsu's construction for the terms "value" or "test result," then all of the asserted claims will be non-infringed on that basis. If the Court adopts Hamamatsu's construction for the term "another value," then asserted claim 17 will be non-infringed on that basis. If the Court adopts Hamamatsu's construction for the terms "control system," "measuring circuit," or "signal processor," then claims 21-25 will be invalid for indefiniteness. If the Court adopts Hamamatsu's construction for the term "signal processor," then claims 21-25 will be non-infringed on that basis.

SEMICAPS's Position. SEMICAPS disagrees with Hamamatsu's assertion that the constructions of "value", "test result", "another value" or "signal processor" are case or claim dispositive. While Hamamatsu's proposed constructions for these terms are inaccurate and would result in an improper interpretation of the claims, the accused products infringe the asserted claims under either parties' construction.

1 **4. Length of Time For Claim Construction Hearing (Pat. L.R. 4-3(d))**

2 The parties anticipate that the length of time necessary for the Claim Construction hearing will
3 be three (3) hours.

4 **5. Witnesses To Be Called At Claim Construction Hearing (Pat. L.R. 4-3(e))**

5 Neither party intends to call a witness at the Claim Construction Hearing.

6 **6. Identification Of Factual Findings (Pat. L.R. 4-3(f))**

7 At this time, the parties do not identify any factual findings related to Claim Construction.
8
9

10 Dated: August 30, 2019

11 By: /s/ Ryan J. Marton

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ATTESTATION IN CONCURRENCE OF FILING

In accordance with the Northern District of California's General Order No. 45, Section X.(B), I, Ryan Goldstein, attest that concurrence in the filing of this document has been obtained from each of the other signatories who are listed on the signature pages.

Dated: August 30, 2019

By: /s/ Ryan S. Goldstein
Ryan Goldstein